UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/760,035	KUBLER ET AL.
	Examiner	Art Unit	
	BRIAN ROBERTS	2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 June 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>22-38,54-59 and 78-121</u> is/are pending in the application.

    4a) Of the above claim(s) <u>96-121</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>22-38,54-59 and 78-95</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>07/17/2008; 06/23/2008</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

- Claims 22-38, 54-59, and 78-121 remain pending.

- The examiner's assertion of official notice in the previous office action is taken
  to be admitted prior art because the applicant failed to traverse the examiner's
  assertion of official notice. See MPEP § 2144.03 (c).

Election/Restrictions

Newly submitted claims 96-121 are directed to an invention that is independent
or distinct from the invention originally claimed for the following reasons: the invention
originally claimed and claims 96-121 are related as subcombinations disclosed as
usable together in a single combination. The subcombinations are distinct if they do not
overlap in scope and are not obvious variants, and if it is shown that at least one
subcombination is separately usable. In the instant case, subcombination of claims 96-
121 has separate utility such as selecting a transmission data rate for transmissions
between two stations. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented
invention, this invention has been constructively elected by original presentation for
prosecution on the merits. Accordingly, claims 96-121 are withdrawn from
consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and
MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 78-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Computer-readable storage" nor the limitation " A computer-readable storage, having stored thereon a computer program having a plurality of code sections for operating a portable terminal device supporting voice communication via a wireless packet network, the code sections executable by a processor for causing the processor to perform the operations" was disclosed or defined in the original disclosure, thus the limitation is considered new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22, 26-30, 36-38, 54, 56-57, 78, 80-81, and 84-95 are rejected under 35

U.S.C. 103(a) as being unpatentable over Heidari (US 5550893) in view of Mahany (US

4910794).

- In reference to claim 22

In Figure 1, Heidari teaches a mobile telephone that includes:

- a microphone (12) for transducing sound into a first analog voice stream

- at least one converter (70,42) for converting the first analog voice stream to
  produce digital voice packets

- a transmitter (48) for transmitting via a wireless packet network (20) the digital
  voice packets from the at least one converter (70,42)

- a receiver (50) for receiving digital voice packets from a base station in the
  wireless packet
  network (20)

- the at least one converter (72,68) for converting received digital voice packets
  to a second analog voice stream

- a transducer (14) for transducing the second analog voice stream into sound.

Heidari does not teach the mobile telephone evaluates a message wirelessly

received from the base station and sends to the base station an indication of a data rate

based on the evaluation; and wherein the base station selects a data rate for

transmitting digital voice packets to the mobile telephone, based upon the indication of a

data rate.

Mahany teaches a system and method that includes a mobile telephone

evaluates a message wirelessly received from a base station (column 22 lines 3-19)

and sends to the base station an indication of a data rate based on the evaluation

(column 22 lines 20-24); and wherein the base station selects a data rate for

transmitting messages to the mobile telephone, based upon the indication of a data

rate. (column 22 line 25-27)

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify the system and method of Heidari to include the mobile

telephone evaluating a message wirelessly received from the base station and sending

to the base station an indication of a data rate based on the evaluation; and wherein the

base station selects a data rate for transmitting digital voice packets to the mobile

telephone, based upon the indication of a data rate as suggested by Mahany because it

provides for maintaining reliable performance in fringe reception areas by adaptively

selecting the best data rate dynamically according to changing operating conditions.

- In reference to claim 26, 56, 80

The combination of Heidari and Mahany teaches a system and method that

covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further

teaches the wireless packet network communicates using a frequency hopping spread

spectrum technique. (column 3 lines 40-45)

- In reference to claim 27, 57, 81

The combination of Heidari and Mahany teaches a system and method that covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further teaches wherein the wireless packet network communicates using a direct sequence spread spectrum technique. (column 3 lines 40- 45)

- In reference to claim 28

The combination of Heidari and Mahany teaches a system and method that covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further teaches the converter includes an analog to digital converter (70) for converting the first analog voice stream to digital voice data and a packetizer (42) for assembling the digital voice data to produce digital voice packets.

- In reference to claim 29

The combination of Heidari and Mahany teaches a system and method that covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further teaches the converter includes a depacketizer (44) for extracting digital voice data from received digital voice packets; and a digital to analog converter (72) for converting the extracted digital voice data to produce the second analog voice stream.

- In reference to claim 30

In Figure 1, Heidari teaches a circuit for supporting voice communication via a wireless packet network that includes:

- at least one converter (70,42) for converting a first analog voice stream to produce digital voice packets

- a transmitter (48) for transmitting via the wireless packet network the digital voice packets from the at least one converter (70,42)

- a receiver (50) for receiving digital voice packets from a base station in the wireless packet network

- the at least one converter (44,72) for converting received digital voice packets to a second analog voice stream

Heidari does not teach the circuit evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the base station selects a data rate for transmitting digital voice packets to the mobile telephone, based upon the indication of a data rate.

Mahany teaches a system and method that includes a mobile telephone evaluates a message wirelessly received from a base station (column 22 lines 3-19) and sends to the base station an indication of a data rate based on the evaluation (column 22 lines 20-24); and wherein the base station selects a data rate for transmitting messages to the mobile telephone, based upon the indication of a data rate. (column 22 line 25-27)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the system and method of Heidari to include the circuit evaluating a message wirelessly received from the base station and sending to the base station an indication of a data rate based on the evaluation; and wherein the base

station selects a data rate for transmitting digital voice packets to the mobile telephone,

based upon the indication of a data rate as suggested by Mahany because it provides

for maintaining reliable performance in fringe reception areas by adaptively selecting the

best data rate dynamically according to changing operating conditions.

-   In reference to claim 36

The combination of Heidari and Mahany teaches a system and method that

covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further

teaches a transducer (14) for convening the second analog voice stream into sound.

-   In reference to claim 37

The combination of Heidari and Mahany teaches a system and method that

covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further

teaches a keypad (30) for receiving user input.

-   In reference to claim 38

The combination of Heidari and Mahany teaches a system and method that

covers substantially covers all limitations of the parent claim. In Figure 1, Heidari further

teaches a display device (30) to provide visual feedback to a user.

-   In reference to claim 54, 78

In Figure 1, Heidari teaches a method of operating a portable terminal device for supporting voice communication via a wireless packet network (20) that includes:

- receiving digital voice packets (50) via the wireless packet network (20)

- converting the received digital voice packets to a first analog voice stream (44, 72)

- transducing the first analog voice stream to produce sound (14)

- converting sound to a second analog voice stream (12)

- converting the second analog voice stream to digital voice packets (70,42)

- sending via the wireless packet network (20) the digital voice packets converted from the second analog voice stream (48).

Heidari does not teach evaluating a message wirelessly received from the base station; sending an indication of a data rate based on the evaluation; and wherein the sender of the received digital voice packets selects the data rate based upon the indication of a data rate sent by the portable terminal device.

Mahany teaches a system and method that includes a mobile telephone evaluates a message wirelessly received from a base station (column 22 lines 3-19) and sends to the base station an indication of a data rate based on the evaluation (column 22 lines 20-24); and wherein the base station selects a data rate for transmitting messages to the mobile telephone, based upon the indication of a data rate. (column 22 line 25-27)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the method of Heidari to include evaluating a message

wirelessly received from the base station; sending an indication of a data rate based on the evaluation; and wherein the sender of the received digital voice packets selects the data rate based upon the indication of a data rate sent by the portable terminal device as suggested by Mahany because it provides for maintaining reliable performance in fringe reception areas by adaptively selecting the best data rate dynamically according to changing operating conditions.

- In reference to claim 84, 87, 93

The combination of Heidari and Mahany teaches a system and method that covers substantially covers all limitations of the parent claim. Mahany further teaches the evaluated message is received periodically via the wireless packet network. (column 11 line 40 - column 12 line 25)

- In reference to claim 85, 88, 91, 94

The combination of Heidari and Mahany teaches a system and method that covers substantially covers all limitations of the parent claim. Mahany further teaches the message received periodically is a polling message. (column 11 line 40 - column 12 line 25)

- In reference to claim 86, 89, 90, 92, 95

The combination of Heidari and Mahany teaches a system and method that covers substantially covers all limitations of the parent claim. Mahany further teaches

evaluating evaluates reception of a message preamble. (column 6 line 54 - column 7

line 6)

Claims 25, 31, 55, and 79 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Heidari (US 5550893) in view of Mahany (US 4910794), as applied to

the parent claims, in view of the admitted prior art.

- In reference to claim 25, 31, 55, 79

The combination of Heidari and Mahany teaches a system and method that

covers substantially covers all limitations of the parent claim.

The combination of Heidari and Mahany does not explicitly teach the wireless

packet network communicates at a frequency of approximately 2.4 gigahertz.

The admitted prior art teaches a wireless packet network communicating at a

frequency of approximately 2.4 gigahertz.

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify the system and method of the combination of Heidari and

Mahany to include the wireless packet network communicates at a frequency of

approximately 2.4 gigahertz as taught by the admitted prior art in order to conform to

governmental regulations and industry standards and avoid interference with other

communication equipment operating on different frequencies.

Claims 23-24, 32-33, 58-59, and 82-83 rejected under 35 U.S.C. 103(a) as being

unpatentable over Heidari (US 5550893) in view of Mahany (US 4910794), as applied to

the parent claims, in view of Gleeson et al. (US 54467736).

-   In reference to claims 23-24, 32-33, 58-59, 82-83

The combination of Heidari and Mahany teaches a system and method that

covers substantially covers all limitations of the parent claim.

The combination of Heidari and Mahany does not explicitly teach that the

wireless packet network uses TCP over IP.

Gleeson et al. teaches a wireless packet network that utilizes a TCP over IP.

(column 12 lines 56-65)

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify the system and method of Heidari to include the wireless packet

network utilizing TCP over IP as taught by Gleeson et al. because it allows the wireless

access network to utilize a standard protocol for data transmissions.

Response to Arguments

Applicant's arguments with respect to independent claims have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRIAN ROBERTS whose telephone number is

(571)272-3095. The examiner can normally be reached on M-F 10:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSR
10/07/2008

/Wing F. Chan/
Supervisory Patent Examiner, Art Unit 2619
10/08/08